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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/490,495 01/25/00 BLUMENAU T 28049/36074

EXAMINER

TM02/0131

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ART UNIT

PAPER NUMBER

2165

DATE MAILED:

01/31/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No. 09/490,495	Applicant(s) Blumenau
	Examiner Cuong H. Nguyen	Group Art Unit 2165
		

Responsive to communication(s) filed on Jun 2, 2000

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle* 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claim

Claim(s) 66-85 and 101-181 is/are pending in the application.  
 Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 66-85 and 101-181 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been  
 received.  
 received in Application No. (Series Code/Serial Number) \_\_\_\_\_.  
 received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892  
 Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_  
 Interview Summary, PTO-413  
 Notice of Draftsperson's Patent Drawing Review, PTO-948  
 Notice of Informal Patent Application, PTO-152

**-- SEE OFFICE ACTION ON THE FOLLOWING PAGES --**

**DETAILED ACTION**

1. This Office Action is the answer to the communication received on 6/02/2000 (the 2<sup>nd</sup> preliminary amendment), which paper has been placed of record in the file.
2. Claims **66-85, 101-181** are pending in this application.

***Drawings***

3. This application has been filed with informal drawings, and they are required to be corrected as indications of the draftsman.

***Specification Objection***

4. The disclosure is objected to because of the following informality:

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: "Content display monitoring by a computer system" (because the specification is directed toward monitoring contents using computer system).

Appropriate correction is required.

5. The following rejections are based on the examiner's broadest reasonable interpretation of the claims; In re Pearson, 181 USPQ 641 (CCPA 1974).

**Claim Rejections - 35 USC § 101**

**6. 35 U.S.C. 101 reads as follows:**

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

A. Claims 101, 126, 135 are rejected under 35 U.S.C. 101 because this claim is directed to a non-statutory subject matter for computer-related inventions. The non-statutory subject matter of the claim is: a content display site. It claims ~~a site~~/(an Internet homepage) (???) that comprised of ~~virtual data~~; at best, it claims a data structure per se if it comprises a functional descriptive material (see Examination Procedures for computer-related inventions ver. 2/27/1996).

B. The remaining claims (102-115, 127-133, 136-139), not specifically mentioned, are rejected for incorporating the above defect from their respective parent claim by dependencies.

C. Claims 66-67, 116, 140, 161 are rejected under 35 U.S.C. 101: These claims are considered as do not contain any specific limitation to a practical application because those claims merely suggest --in general-- a method/medium for monitoring displays having very broad steps/functions of: receiving a program, monitoring displays, generating data, evaluating content positions, and transferring/transmitting data (instead of giving more specific limitations in the body of

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claims to clarify claimed subject matters, these claims essentially repeat general information presented in the preamble; see Examination Procedures for Computer-Related Inventions published on 2/27/1996).

D. The remaining claims (68-85, 117-125, 141-147, 162), not specifically mentioned, are rejected for incorporating the above defect from their respective parent claim by dependencies.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 66, 116 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. Viewing as a whole, claims 116, 163 must include a computer-implemented method in the preamble to clarify a field of use for the claimed subject matter (See at least the specification for the obvious use of a computer system/(a computer network) in this application).

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B. Claims 117-125, and 164-166 are rejected for incorporating a defect from their parent claims by dependencies.

C. Claim 66 recites the limitation "monitoring the display of content"; and "monitoring the position" in 1<sup>st</sup> & 3rd lines of claim 66. There are insufficient antecedent basis for these features in the claim.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

***(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.***

10. Claims 66-85, 101-181 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Curran et al. (UK Patent GB 2250112A), in view of Brown (Using Netscape 2 - Special Edition), Capps (US Pat. ), and further in view of the Official Notice.

Curran et al. disclose a system/method/computer-readable medium for monitoring displays by a computer system, comprising:

- instructions for causing the content to be displayed by a computer system (inherently in Curran et al.'s patent);

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- means/step/instructions for monitoring a position/a change in time of an image on a display screen (of a content characteristic) (see Curran et al., pp. 4:9-12, 5:3-8, 17-23); Curran et al. don't discuss a means for determining a duration of each time if a display is hidden by other images.

Brown --this reference was supplied in the parent case 's Office Action-- further suggests there is a means/instructions for determining a duration of each time if a display is hidden by other images (see Brown, pp. 270, 805, 720-721) (this is also a limitation in claim 66 about evaluating a position of a content display). Furthermore, Capps clearly discloses that fact with Figs. 7 & 10, 12:64-67 and

- means/step/instructions for monitoring/evaluating/comparing/judging a position/a change in time of an image on a display screen (see Curran et al., pp. 5:6-7 and 5:13-16).

Curran et al. do not expressly disclose about transmitting monitoring information between sites in response to a signal.

However, Brown (Using Netscape 2 - Special Edition) obviously suggests that feature.

The Official Notice is taken here that a step of receiving a specific program (e.g. a monitoring program) over the Internet (in claim 148); downloading data to a specific address,

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downloading time, uploading data/(time duration) (in claim 167) is notoriously well-known in computer art.

A. The examiner submits that these claims' limitations are obvious because Curran et al., Capps, and Brown need not necessary spelled-out exactly claimed languages, because their suggestions also directed to a similar system for monitor displaying/controlling; their limitations are not limited to described embodiments in these disclosures. It is reasonable that various modifications and variations of their systems/steps would be apparent to those skilled in the art at the time of invention without departing from the scope and spirit of the invention. Although their disclosures have been described in connection with specific preferred embodiments, it should be understood that their limitations should not be unduly limited to such specific embodiments. It is to be understood that various changes and modifications can be effected therein by one skilled in the art without departing from the spirit or scope of the cited prior art.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to implement Curran et al. 's system with Brown & Capps 's suggestions because it increases a completeness in monitoring a display of content by a computer system.

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11. Claims **66-85, 101-181** are rejected under 35 U.S.C. §103(a) as being unpatentable over Curran et al. (GB 2250112 - 5/27/92), in view of Brown (Using Netscape 2 - Special Edition), in view of Cannon et al. (US Pat. 5,673,382), and further in view of the Official Notice.

The rationales for rejection of claim 167 are incorporated herein.

The Official Notice is taken here that all communications over a network (e.g. Internet) to different servers coupled to that network are notoriously well-known to a person with skills in the art of networking. The limitation of claim **172** is obvious from claim 167 with uploading specific data (an identifying mark/indicia and a related time amount).

#### *Conclusion*

12. Claims **66-85, 101-181** are rejected.

13. The attached references are considered pertinent to applicant's disclosure.

- Curran et al. (UK Pat. GB 2250112A), Computer testing capture device, 05/27/1992.
- Shibata et al., (US Pat. 5,835,923 - 11/10/1998), Contents information transmitting/viewing system and method therefor.
- Pan, (US Pat. 5,926,168 -- 7/20/1999), Remote pointers for interactive televisions.

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- Tsai, (US Pat. 5,495,581 - 2/27/1996), Method and apparatus for linking a document with associated reference information using pattern matching.
- Capps (US Pat. 5,634,100 - 5/27/1997), System and method for event parameter interdependence and adjustment with pen input.
- Halliday, FastCAD offers speed, 3-D rendering features, InfoWorld, v13n49, pp.98-105, 12/09/1991.
- Halliday, Product Comparison: High-End CAD, InfoWorld, v13n16, pp.55-75, 4/22/1991.
- Lubow, An engineer's guide to AutoCAD, Industrial Engineering, v19n8, pp.ESC18-ESC20, 8/1987.
- Parks et al., New workstation from SunRiver Corp. Offers highest CAD performance at affordable price, Business Wire, s1 p1, 6/11/1990.
- McGrath, The tail-less mouse: is innovative mouse missing more than just a tail?, Computer Graphics World, v11, p117(2), 10/1988.
- Lombardi, Windows Word Processors: InfoWorld tests the tools and features in six of the high-end graphical products, InfoWorld, v14n6, pp.78-96, 2/10/1992.

14. Remarks:

- A. In re **Hiniker Co.**, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998) the court ruled: "The name of the game is the claim."

B. Although operational characteristics of an apparatus may be apparent from the specification, we will not read such characteristics into the claims when they cannot be fairly connected to the structure recited in the claims. See *In re Self*, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982). When given their broadest reasonable interpretation, the claims on examination sweep in the prior art, and the prior art would have directed an artisan of ordinary skill to make the combination cited by the examiner to discloses a structure that meets the claim limitations.

The use of a specific method may be outstanding in its field, but the name of the game is the claim. See **Giles Sutherland Rich**, Extend of Protection and Interpretation of Claims -- American Perspectives, 21 Int'l Rev. Indus. Prop. & Copyright L. 497, 499 (1990) ("The US is strictly an examination country and the main purpose of the examination, to which every application is subjected, is to try to make sure that what each claim defines is patentable. To coin a phrase, the name of the game is the claim.")

C. About Method-of-Use claims: When considering a method-of-use claim (steps for operating a specific structural assembly), patentable weight is given to the structure on which the claimed

process is carried out in determining the obviousness of that process; *In re Kuehl*, 177 USPQ 250 (CCPA 1973); and

D. About structural limitations in method claims :

To be entitled to weight in method claims, the recited structure limitations therein must affect the method in a manipulative sense, and not to amount to the mere claiming of a use of a particular structure, *ex parte Pfeiffer*, 1962 C.D. 408 (1961).

E. About a basis for claiming criticality:

It is an established principle of law that a limitation merely with respect to proportions in a composition of matter or process will not support patentability unless such limitation is "critical". (e.g. , *Minerals Separation, Ltd. v. Hyde*, 242 U.S. 261 (1916)).

F. In re Conrad, 169 USPO 170 (CCPA 1971), the court said:

The test for obviousness under 35 U.S.C. 103 is not the express suggestion of the claimed invention in any or all of the references but what the references taken collectively would suggest.

G. The type of claims here are very common among software patents, and claiming the desired functional features of the invention, without limitation to its implementation. That is, the claim can be viewed as covering the steps necessary from a

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business perspective to achieve the desired business goal of providing content monitoring. Thus, software, claimed at the level of useful functionality must have implementation limitations. Claims need to be limited to low level manipulations.

43. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Cuong H. Nguyen, whose telephone number is (703) 305-4553. The examiner can normally be reached on Monday-Friday from 7:00 AM-4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent A. Millin, can be reached on (703) 308-1065.

**Any response to this action should be mailed to:**

Box Issue Fee	Amendments
Commissioner of Patents and Trademarks	
c/o Technology Center 2100	
Washington, D.C. 20231	
<b>or faxed to:</b> (703) 308-9051, (for formal communications)	
<b>Or:</b> (703) 305-0040 (for informal or draft communications)	
Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).	

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

*Cuonghnguyen*

Cuong H. Nguyen  
Patent Examiner  
Jan. 27, 2001